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09/781,654	02/12/2001	Craig R. White	10003981-1	9495

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EXAMINER
LEVINE, ADAM L

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/781,654

Applicant(s)

WHITE, CRAIG R.

Examiner

Adam Levine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2005.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
  - 4a) Of the above claim(s) 20-22 and 29-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 23-28, and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
  - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) ☐ All b) ☐ Some \* c) ☐ None of:
      - 1. ☐ Certified copies of the priority documents have been received.
      - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date various (5 forms).

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Claims 1-19, 23-28, and 35 in the reply filed on April 12, 2005, is acknowledged. Claims 20-22 and 29-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 12, 2005.

### ***Information Disclosure Statement***

2. The information disclosure statement filed March 13, 2003, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The Deschrijver document (WO0069180, Nov. 16, 2000) was not provided and has not been considered.

### ***Specification***

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because of the following informalities: In the Brief Description of the Drawings, Figure 4 is inaccurately described.

Appropriate correction is required.

### ***Claim Objections***

**4. Claims 7, 9, 14, 23, and 26 are objected to because of the following informalities:**

Claim 7 introduces "a second fixed service provider database," however, the first service provider database is described only as a "first service provider database." It is unclear whether there are two fixed service provider databases or whether "fixed" is intended to further modify the second service provider database. Appropriate correction is required.

Claim 9 refers to "selected services," however Claim 9 depends from Claim 8. Claim 8 establishes only a single selected service. Appropriate correction is required.

Claim 26 describes "services available to the user interface" in line 3. The wording of the claim is unclear. It could be describing service providers being displayed based on services available to the user interface; or service providers being displayed to the user interface based on a predetermined set of available services. Appropriate correction is required.

Claims 14, 23, and 26 recite the limitation "Internet portal." The claims alternate back and forth between using the phrase "network portal" and the phrase "Internet portal." Although the terms "Internet portal" and "network portal" could refer to the same

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portal, the terms are not interchangeable. It is unclear whether the claims are intended to refer to the same portal throughout. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 4, 27, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In Claim 4 the term "independent of exclusive control" is a relative term that renders the claim indefinite. The term "independent of exclusive control" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Because the word "independent" is in opposition to the words "exclusive control," the use of the term "independent of exclusive control" renders indefinite the amount of control exercised by the network portal.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. Although Claim 27 is directed to a system, it does not claim any structural elements.

**Claim Rejections - 35 USC § 101**

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 27 and 28 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.**

The claims are directed to a process that does nothing more than manipulate an abstract idea. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. There is no practical application in the technological arts to support the core invention. System components as claimed (and means) are software components lacking structural specificity. For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-4, 8, 15-24, 27, 28 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Triggs (GB 2329488 A).**

Triggs teaches all the limitations of Claims 1-4, 8, 15-24, 27, 28, and 35. For example, Triggs discloses a network portal constructed by accessing a database of service providers that have self-selected their inclusion into the database (see at least p. 1; line 25 – p. 2 line 13). Triggs further discloses:

- accessing the portal with a network-capable computing device: (see at least p. 1; line 25 – p. 2 line 16); creating a communication connection between the service provider and the service provider database (see at least p. 1; line 25 – p. 2 line 13).
- displaying keyword-service links on the network portal: in association with the service providers; viewing a list of available services on the network portal (see at least p. 2 lines 14-19; p. 3 lines 16-19).
- displaying a link on the network portal for activation by a user: to connect to the service provider; selecting a service for access by the user; invoking a

service location to connect the user interface to the service provider and permit user access to the selected service (see at least p. 2 lines 17-21).

- displaying at least one criteria function: for permitting a user to specify further criteria for selecting a group of service providers from the first service provider database (see at least p. 2 lines 17-21; p. 3 lines 16-22; p. 4 lines 30-36; p. 5 lines 19-27).
- accessing a database of service providers: displaying a service document on the user interface providing information on the type and manner of service provided by a service provider; in association with keywords; creating a list of keywords that represent the service provided and inserting the keyword list into the service document (see at least abstract; (see at least p. 2 lines 22-33; p. 3 line 37- p. 4 line 6).
- submitting type of service keywords displayed on the network portal to the first service provider database for matching with types of services offered by service providers in the first service provider database (see at least p. 3 lines 16-22, p. 5 lines 14-27); retrieving from the first service provider database a list of service providers that match the type-of-service keywords (see at least p. 5 lines 14-27)
- insuring that the service document is up-to-date prior to its inclusion into the service provider database: (see at least p. 2 lines 22-26; p. 3 lines 4-15).

Pertaining to system Claims 23, 24, 27, 28



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Rejection of Claims 23, 24, 27, and 28 is based on the same rationale as noted above.

**Pertaining to computer readable medium Claim 35**

Rejection of Claim 35 is based on the same rationale as noted above.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5,6, 9-12, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Triggs (GB 2329488 A) in view of Newman (US Pub. 2002/0069176).**

Triggs teaches a network portal constructed by accessing a database of self selected service providers and displaying keyword service links on the portal in connection with the service providers as noted under the 102(b) rejection. Triggs also teaches a) displaying only keyword service links of predetermined types, b) where those types are based on previous choices of the user, c) where those choices are made through the presentation of criteria to the user or through the use of keywords and key word searches, and d) services being accessed through the portal by the user. Triggs, however, does not teach the set of predetermined types having been

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purchased by a user in a fee for service arrangement with the portal; displaying only keyword-service links matching a set of predetermined user preferences; and arranging for fee for service payment for selected services through a user account associated with the network portal and based on a predetermined arrangement between the user and the network portal. Newman teaches the set of predetermined types having been purchased by a user in a fee for service arrangement with the portal (see at least abstract; p. 2, 0018). Newman further teaches:

- displaying only keyword-service links matching a set of predetermined user preferences: comparing each keyword-matched service provider against a set of predetermined user profile criteria; displaying links to user-profile matched services offered by the service providers; determining whether the type and number of service providers matches the user profile criteria (see at least abstract; p. 2, 0018; Fig. 4A), and
- arranging for fee for service payment for selected services through a user account associated with the network portal and based on a predetermined arrangement between the user and the network portal: (see at least p. 2, 0026).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the network of Triggs to include a fee for service arrangement as taught by Newman in order to derive financial benefit from the network while providing ease of use and facilitating commerce between the users and providers of the portal.

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Pertaining to system Claims 25, 26

Rejection of Claim 25, 26 is based on the same rationale as noted above.

**Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Triggs (GB 2,329,488 A) in view of Krishan (US 6,442,529 B1).**

Triggs teaches a network portal constructed by accessing a database of self-selected service providers and displaying keyword service links on the portal in connection with the service providers as noted under the 102(b) rejection. Triggs also teaches a) displaying only links of selected providers, b) displaying links of providers that have access to their own information for updating purposes, and c) the natural ability of portals to restrict providers' ability to get their information referenced. Triggs, however, does not teach a fixed service provider database including service providers with a fee for display arrangement with the portal for display of a link to each fee for display service provider. Krishan teaches a fixed service provider database including service providers with a fee for display arrangement with the portal for display of a link to each fee for display service provider (see at least abstract; Figs. 1A and 1B; column 2 lines 46-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the network of Triggs to include a database of providers with a fee for display arrangement with the portal as taught by Krishan in order for the portal to derive financial benefit from the network while facilitating commerce between the users and providers on the portal.

**Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Triggs (GB 2329488 A) and Newman (US Pub. 2002/0069176), as applied to claim 10 above, and further in view of Krishan (US 6,442,529 B1).**

Triggs and Newman teach all of the above as noted under the 102(b) and 103(a) rejections and teach a) databases of service providers, b) displaying only links of selected providers, and c) services being accessed through the portal by the user, but do not disclose service providers exclusively selected by the network portal and having a fee-for-display contractual arrangement with the network portal. Krishnan teaches service providers exclusively selected by the network portal and having a fee-for-display contractual arrangement with the network portal (see at least abstract; Figs. 1A and 1B; column 1 lines 46-54; column 6 lines 18-20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the networks and systems of Triggs and Newman to include a fee-for-display arrangement between the network portal and service providers and allow the portal to exclusively select service providers as taught by Krishan, in order to generate revenue for the portal using the portal's ability to exercise greater control over provider access, while providing more service to the users and thereby attracting more users and providers to the portal.

**Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **Wong, US Pat. No. 5,890,175; March 30, 1999.** Teaches computerized method for dynamically generating a catalog by a merchant with fields optionally associated with linked objects.
- **Dunworth, US Pat. No. 5,930,474; July 27, 1999.** Teaches a software interface that organizes information. A local content database and a yellow pages database are provided to allow the user to obtain information at different levels. Includes information about general goods and services and specific goods and services within a given geographic location and information about.
- **Dean, US Pat. No. 6,055,512; April 25, 2000.** Teaches a service terminal for providing users information by comparing user data with information on types of available data, and allows users to instruct service providers.
- **Conklin, US Pat. No. 6,141,653; Oct. 31, 2000.** Teaches multivariate negotiations engine allowing seller to create website for inclusion in database searchable by buyer.
- **Faber, US Pub. No. 2002/0010608; Jan. 24, 2002.** Teaches customer/provider matching system including website with provider information searchable by customer based on criteria and provider availability.

- **Bowen, US Pat. No. 6,094,649; July 25, 2000.** Teaches methods and systems for keyword searches in structured, relational databases. Items are selected and indexed by web crawler or other indexing agent that produces an index associating keywords with resource locators such as URLs, hot links, or file paths. Index provides a resource locator associated with a keyword provided by a user. Resource locator is then used to retrieve document with current data from database that is provided to the user.
- **Gerace, US Pat. No. 5,848,396; Dec. 8, 1998.** Teaches display of information to appropriately selected users based on users' psychographic profile.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 571.272.7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adam Levine  
Patent Examiner  
April 29, 2000

  
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